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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,192	06/12/2001	Michael G. Walker	PB-0009-1 CIP	7368

27904 7590 08/13/2002

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EXAMINER

GUNTER, DAVID R

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 08/13/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,192

Applicant(s)

WALKER ET AL.

Examiner

David Gunter

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 4-12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Traverse

The examiner acknowledges the applicant's election with traverse of Group I, Claims 1-3 and 13-14 in paper number 7, dated June 13, 2002. The applicant has further elected SEQ ID NO: 41. The grounds for traversal appears to be that the applicants "were under the impression that one method within the scope of the product claim could be examined with the composition without placing undue burden on the examiner."

This argument is not found to be persuasive. The Claims of Group I are drawn to a polynucleotide of SEQ ID NO: 41, a complement thereof, a composition consisting of a polynucleotide of SEQ ID NO: 41 and a labeling moiety, a vector comprising a polynucleotide of SEQ ID NO: 41, and a host cell comprising a polynucleotide of SEQ ID NO: 41. Groups II – V represent methods of using the polynucleotide of Group I to screen a plurality of molecules, purify a ligand, detect gene expression, and produce protein, respectively. Each of these methods of use are distinct from one another due to differences in their mode of operation, use, and expected results. As such, the methods are not related to one another.

The polynucleotide of Group I is related to the methods of Groups II – V as a product and process of use. The product (the polynucleotide of Group I) is considered to be patentably distinct from the processes of use because the product can be used in any of the four materially different processes recited in Groups II – V. For this reason the restriction requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 101 and 112

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-3 and 13-14 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by a specific utility because the disclosed uses of the polynucleotide are not specific and are generally applicable to any polynucleotide. The specification discloses many potential uses for the polynucleotide including detecting gene expression (page 3, line 4), as a probe (page 12, line 23), and "for expressing mRNA and protein, or conversely to block transcription or translation of the mRNA" (page 14, lines 9-10). These are non-specific uses that are applicable to polynucleotides in general and not particular or specific to the polynucleotide claimed.

Further, the claimed polynucleotide is not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. In this case the polynucleotide is known only to be co-expressed with creatine kinase M (page 24, line 31), and has no asserted or identified specific and substantial utilities. The research contemplated by the applicants to characterize uses for the polynucleotide does not constitute a specific and substantial utility. Similarly, the other listed and asserted utilities as summarized above or in the instant specification are neither substantial nor specific due to being generic in nature and

applicable to a myriad of such compounds. Note, because the claimed invention is not supported by a specific and substantial asserted utility for the reasons set forth above, credibility has not been assessed. Neither the specification as filed nor any art of record discloses or suggests any property or activity for the polynucleotides such that another non-asserted utility would be well established for the compounds.

2. Claims 1-3 and 13-14 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific or substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

3. **No claims are allowed.** However, the examiner notes that the claims are free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R. Gunter whose telephone number is (703) 308-1701. The examiner can normally be reached on 9:00 - 5:00 M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-9212 for regular communications and (703) 308-8724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0198.



David R. Gunter, DVM, PhD
August 8, 2002


STEPHEN S. BRUMER
PRIMARY EXAMINER